UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,216	05/07/2004	Douglas S. Parker	SPT0001-US	9689

7590   06/07/2005

Michael D. Bednarek
Shaw Pittman LLP
1650 Tysons Boulevard
McLean, VA 22102

EXAMINER
MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _08 March 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-22_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _07 May 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Non-Final Office action is responsive to Applicant's preliminary amendment

filed March 8, 2005.

Claims 1, 2, 4, 9, 14, 15, 17, 18, 20, and 22 have been amended.

Claims 1-22 are presented for examination.

Claim Objections

2.   Claim 15 is objected to because of the following informalities:

Claim 15, line 1, delete extra occurrence of "of the"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claims contain subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventors, at the time the application was filed,

had possession of the claimed invention. Furthermore, claims 1-22 are rejected under

35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The claims contain subject matter which was not described in the specification in such a

way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention.

Independent claim 1 recites the steps of "defining in a computer...", "associating,

using a computer, a process...", and "associating, using a computer, a characteristic..."

The scope of these steps and the extent to which the computer is involved are unclear.

Who or what performs the defining and the two recited associating steps? Does

"defining" merely refer to a human user entering data related to the operation as a value

chain or does the computer actually execute some sort of analysis to determine the

operation as a value chain? Similarly, do the steps of "associating" merely refer to a

human user entering data related to the recited process and element or does the

computer actually execute some sort of analysis in addition to the mere input of process

and element data? The Examiner has looked toward the specification and has found no

guidance beyond the disclosure of a human user inputting all recited data into the

computer to be displayed (i.e., without any extraneous analysis performed by the

computer). Therefore, claim 1 contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventors, at the time the application was filed, had possession of the claimed

invention. Furthermore, the preamble of claim 1 recites a "computer-implemented

method for analyzing an operation of an organization"; however, the body of claim 1

does not accomplish what the preamble sets out to complete (i.e., analyze an operation

of an organization). Based on Applicant's disclosure, the human user inputs all data

and the computer merely regurgitates this data in the form of a display (e.g., a matrix,

as indicated in dependent claim 2); however, the computer itself does not perform any

extraneous analysis of the data beyond what is needed to display the data in the form of

a matrix. Therefore, it is not evident that any analysis of the organization is expressly

performed, thereby rendering the claim vague and indefinite. As a matter of fact, all

implied analysis is performed in the mind of a human user. The computer is merely

used as a tool to output data input by the human user in the form of a matrix, which

requires minimal processing and no express analysis on the part of the computer.

Since all analysis is performed in the mind of the user, the results of the claimed

invention are entirely subjective and non-repeatable, thereby failing to produce a

concrete result. Due to this subjective nature, non-repeatability, and inconcrete nature

of the claimed invention, the Examiner submits that the claimed invention was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention

without undue experimentation. Furthermore, since the specification fails to fill in the

gap regarding who or what is performing analysis or even if any meaningful analysis

occurs at all, the Examiner submits that claims 1-13 contain subject matter which was

not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventors, at the time the application was filed, had

possession of the claimed invention.

Claim 1 recites the step of "displaying on a computer user interface the

associated characteristic, process, and element as associated." It is unclear whether

the "associated characteristic, process, and element as associated" refer to the fact that

these three elements are displayed at once or merely linked together via information

common to various displays. The Examiner has looked toward the specification and

drawings. The drawings fail to show a single display (e.g., a matrix) with all three

elements, especially in light of many of the dependent claims. For example, dependent

claim 5 recites that "the operation comprises an information technology operation,

and...the element comprises one of a client, a server, an enabler, and an application."

These elements are depicted in Figure 1C; however, based on this figure, it is not clear

which columns or rows of the matrix represent the recited characteristic and process as

associated with the illustrated elements. Similarly, claim 11 recites that "the

characteristic of the associated process and element comprises a cost for furnishing the

associated process and element"; however, there is no cost characteristic depicted

anywhere in the drawings, thereby raising more questions as to the intended scope of

the limitation "displaying on a computer user interface the associated characteristic,

process, and element as associated" recited in claim 1. Similar inconsistencies are

recited throughout claims 1-13 without any clarification provided in the specification;

therefore, the Examiner submits that claims 1-13 contain subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventors, at the time the application was filed, had possession

of the claimed invention.

Claim 13 recites the processes of "relate, develop, contract, fulfill, operate,

advise, and manage." These terms are so broad that their intended scope is vague and

indefinite. In a sense, planning any task and then completing the task inherently

involves the processes of "relate, develop, contract, fulfill, operate, advise, and manage" on some level even if merely associated with thoughts that pass through the mind of the task planner. Therefore, the concrete metes and bounds of such processes are ambiguous and the Examiner submits that claim 13 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-13 are dependent from claim 1 and therefore inherit the same rejections under § 112, 1st paragraph.

Independent claim 14 recites the steps of "defining in a computer a value chain...", "defining in a computer a collection of elements", "associating in a computer a process...", "associating in a computer an actor...", and "defining in a computer a scope." The scope of these steps and the extent to which the computer is involved are unclear. Who or what performs the defining and the associating steps? Does "defining" merely refer to a human user entering data related to the value chain processes, elements, and scope of outsourcing or does the computer actually execute some sort of analysis to determine the processes and elements associated with the value chain as well as the scope of outsourcing? Similarly, do the steps of "associating" merely refer to a human user entering data related to the recited process and element or does the computer actually execute some sort of analysis in addition to the mere input of process and element data? The Examiner has looked toward the specification and has found no guidance beyond the disclosure of a human user inputting all recited data into the

computer to be displayed (i.e., without any extraneous analysis performed by the

computer). The Examiner has looked toward the specification and has found no

guidance beyond the disclosure of a human user inputting all recited data into the

computer to be displayed (i.e., without any extraneous analysis performed by the

computer). Therefore, claim 14 contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventors, at the time the application was filed, had possession of the claimed

invention. Furthermore, the preamble of claim 14 recites a "method for outsourcing";

however, the body of claim 14 does not accomplish what the preamble sets out to

complete (i.e., actually outsourcing). Based on Applicant's disclosure, the human user

inputs all data and the computer merely regurgitates this data in the form of a display

(e.g., a matrix, as indicated in dependent claim 15); however, the computer itself does

not perform any extraneous analysis of the data beyond what is needed to display the

data in the form of a matrix. Therefore, it is not evident that any outsourcing is

expressly performed, thereby rendering the claim vague and indefinite. As a matter of

fact, all implied analysis is performed in the mind of a human user. The computer is

merely used as a tool to output data input by the human user in the form of a matrix,

which requires minimal processing and no express analysis on the part of the computer.

Since all analysis is performed in the mind of the user, the results of the claimed

invention are entirely subjective and non-repeatable, thereby failing to produce a

concrete result. Due to this subjective nature, non-repeatability, and inconcrete nature

of the claimed invention, the Examiner submits that the claimed invention was not

described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention

without undue experimentation. Furthermore, since the specification fails to fill in the

gap regarding who or what is performing analysis or even if any meaningful analysis

occurs at all, the Examiner submits that claims 14-19 contain subject matter which was

not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventors, at the time the application was filed, had

possession of the claimed invention.

Claim 14 recites the step of "displaying the scope for the outsourcing on a

computer user interface, the computer user interface graphically presents the

association between the associated actor, process, and element." It is unclear whether

the "associated actor, process, and element" refer to the fact that these three elements

are displayed at once or merely linked together via information common to various

displays. The Examiner has looked toward the specification and drawings. The

drawings fail to show a single display (e.g., a matrix) with all three elements, especially

in light of many of the dependent claims. For example, dependent claim 18 recites the

step of "associating a cost with the associated process and element and displaying the

associated process, element, and cost on the computer user interface"; however, there

is no cost depicted anywhere in the drawings, thereby raising more questions as to the

intended scope of the limitation "displaying the scope for the outsourcing on a computer

user interface, the computer user interface graphically presents the association between

the associated actor, process, and element" recited in claim 14. Similar inconsistencies

are recited throughout claims 14-19; therefore, the Examiner submits that claims 14-19

contain subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventors, at the time the

application was filed, had possession of the claimed invention.

Claims 15-19 are dependent from claim 14 and therefore inherit the same

rejections under § 112, 1st paragraph.

Claims 20-22 recite language that is similar to that recited in claims 1-19 in such

a manner that the relevant portions of the § 112, 1st rejections of claims 1-19 are applied

to claims 20-22 as well.

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Independent claim 1 recites the steps of "defining in a computer...", "associating,

using a computer, a process...", and "associating, using a computer, a characteristic..."

The scope of these steps and the extent to which the computer is involved are unclear.

Who or what performs the defining and the two recited associating steps? Does

"defining" merely refer to a human user entering data related to the operation as a value

chain or does the computer actually execute some sort of analysis to determine the

operation as a value chain? Similarly, do the steps of "associating" merely refer to a

human user entering data related to the recited process and element or does the

computer actually execute some sort of analysis in addition to the mere input of process

and element data? The Examiner has looked toward the specification and has found no

guidance beyond the disclosure of a human user inputting all recited data into the

computer to be displayed (i.e., without any extraneous analysis performed by the

computer).

The preamble of claim 1 recites a "computer-implemented method for analyzing

an operation of an organization"; however, the body of claim 1 does not accomplish

what the preamble sets out to complete (i.e., analyze an operation of an organization).

Based on Applicant's disclosure, the human user inputs all data and the computer

merely regurgitates this data in the form of a display (e.g., a matrix, as indicated in

dependent claim 2); however, the computer itself does not perform any extraneous

analysis of the data beyond what is needed to display the data in the form of a matrix.

Therefore, it is not evident that any analysis of the organization is expressly performed,

thereby rendering the claim vague and indefinite.

Claim 1 recites the step of "displaying on a computer user interface the

associated characteristic, process, and element as associated." It is unclear whether

the "associated characteristic, process, and element as associated" refer to the fact that

these three elements are displayed at once or merely linked together via information

common to various displays. The Examiner has looked toward the specification and

drawings. The drawings fail to show a single display (e.g., a matrix) with all three

elements, especially in light of many of the dependent claims. For example, dependent

claim 5 recites that "the operation comprises an information technology operation,

and...the element comprises one of a client, a server, an enabler, and an application."

These elements are depicted in Figure 1C; however, based on this figure, it is not clear

which columns or rows of the matrix represent the recited characteristic and process as

associated with the illustrated elements. Similarly, claim 11 recites that "the

characteristic of the associated process and element comprises a cost for furnishing the

associated process and element"; however, there is no cost characteristic depicted

anywhere in the drawings, thereby raising more questions as to the intended scope of

the limitation "displaying on a computer user interface the associated characteristic,

process, and element as associated" recited in claim 1. Similarly inconsistencies are

recited throughout claims 1-13, thereby rendering all claims vague and indefinite.

Claim 7 recites that the actor may be an organization, outsourcer for the

organization, or a third party to the organization and the outsourcer. However, if an

organization participates in outsourcing, then the organization itself is also an

outsourcer regardless of whether or not it hires a third party to perform the outsourcing

decisions. In other words, even if a third-party outsourcer working on behalf of the

organization exists, the organization itself it also an outsourcer regardless of who

actually negotiates the outsourcing contracts. Therefore, claim 8 is unclear because it

recites the step of "developing a contract between the organization and the outsourcer

for the outsourcer's furnishing of the associated process and element." If the

organization is an outsourcer (i.e., it utilizes outsourcing), then how can it form a

contract with itself? Furthermore, if the outsourcer is the one (either the organization

itself or a third party) in search of external parties to which to contract work, then the

outsourcer is not actually furnishing the associated process and element. Instead, the

entity to which the associated process and element are outsourced is actually furnishing

them.

Claim 13 recites the processes of "relate, develop, contract, fulfill, operate,

advise, and manage." These terms are so broad that their intended scope is vague and

indefinite. In a sense, planning any task and then completing the task inherently

involves the processes of "relate, develop, contract, fulfill, operate, advise, and

manage" on some level even if merely associated with thoughts that pass through the

mind of the task planner. Therefore, the concrete metes and bounds of such processes

are ambiguous.

Claims 2-13 are dependent from claim 1 and therefore inherit the same rejections

under § 112, 2nd paragraph.

Independent claim 14 recites the steps of "defining in a computer a value

chain...", "defining in a computer a collection of elements", "associating in a computer a

process...", "associating in a computer an actor...", and "defining in a computer a

scope." The scope of these steps and the extent to which the computer is involved are

unclear. Who or what performs the defining and the associating steps? Does "defining"

merely refer to a human user entering data related to the value chain processes,

elements, and scope of outsourcing or does the computer actually execute some sort of

analysis to determine the processes and elements associated with the value chain as

well as the scope of outsourcing? Similarly, do the steps of "associating" merely refer to

a human user entering data related to the recited process and element or does the computer actually execute some sort of analysis in addition to the mere input of process and element data? The Examiner has looked toward the specification and has found no guidance beyond the disclosure of a human user inputting all recited data into the computer to be displayed (i.e., without any extraneous analysis performed by the computer).

The preamble of claim 14 recites a "method for outsourcing"; however, the body of claim 14 does not accomplish what the preamble sets out to complete (i.e., actually outsourcing). Based on Applicant's disclosure, the human user inputs all data and the computer merely regurgitates this data in the form of a display (e.g., a matrix, as indicated in dependent claim 15); however, the computer itself does not perform any extraneous analysis of the data beyond what is needed to display the data in the form of a matrix. Therefore, it is not evident that any outsourcing is expressly performed, thereby rendering the claim vague and indefinite.

Claim 14 recites the step of "displaying the scope for the outsourcing on a computer user interface, the computer user interface graphically presents the association between the associated actor, process, and element." It is unclear whether the "associated actor, process, and element" refer to the fact that these three elements are displayed at once or merely linked together via information common to various displays. The Examiner has looked toward the specification and drawings. The drawings fail to show a single display (e.g., a matrix) with all three elements, especially in light of many of the dependent claims. For example, dependent claim 18 recites the

step of "associating a cost with the associated process and element and displaying the associated process, element, and cost on the computer user interface"; however, there is no cost depicted anywhere in the drawings, thereby raising more questions as to the intended scope of the limitation "displaying the scope for the outsourcing on a computer user interface, the computer user interface graphically presents the association between the associated actor, process, and element" recited in claim 14. Similarly inconsistencies are recited throughout claims 14-19, thereby rendering all claims vague and indefinite.

Claim 16 recites that the outsourcing may occur between an organization and an outsourcer, wherein the actor is either the organization, the outsourcer, or a third party to the organization and the outsourcer. However, if an organization participates in outsourcing, then the organization itself is also an outsourcer regardless of whether or not it hires a third party to perform the outsourcing decisions. In other words, even if a third-party outsourcer working on behalf of the organization exists, the organization itself it also an outsourcer regardless of who actually negotiates the outsourcing contracts. If the organization is an outsourcer (i.e., it utilizes outsourcing), then how can it outsource with itself?

Claims 15-19 are dependent from claim 14 and therefore inherit the same rejections under § 112, 2nd paragraph.

Claims 20-22 recite language that is similar to that recited in claims 1-19 in such a manner that the relevant portions of the § 112, 2nd rejections of claims 1-19 are applied to claims 20-22 as well.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7.　　35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.　　Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Furthermore, mere

intended or nominal use of a component, albeit within the technological arts, does not

confer statutory subject matter to an otherwise abstract idea if the component does not

apply, involve, use, or advance the underlying process.

Claims 1-22 do not incorporate any substantial use of technology (e.g., utilization

of a computer to perform core analysis or calculation steps). While independent claims

1, 14, and 20 have been amended to recite that defining occurs "in a computer",

associating occurs "in a computer", and displaying occurs "on a computer user

interface", the true extent of the computer's involvement beyond mere receipt and

display of data is unclear (as discussed in the rejections under 35 U.S.C. § 112, 1st and

2nd paragraphs above). Furthermore, since all analysis is performed in the mind of the

user, the results of the claimed invention are entirely subjective and non-repeatable,

thereby failing to produce a concrete result. Therefore, claims 1-22 are deemed to be

non-statutory not only for failing to apply, involve, use, or advance the technological

arts, but also for failing to produce a concrete result.

Appropriate correction is required.

In light of the numerous rejections under 35 U.S.C. §§ 101 and 112, 1st and 2nd

paragraphs presented above, the following art rejection reflects Examiner's best

understanding of the claimed invention.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1-7 and 10-12 are rejected under 35 U.S.C. 102(a), (e) as being

anticipated by Barton et al. (US 2002/0059093).

Barton discloses a computer-implemented method for analyzing an operation of

an organization comprising:

[Claim 1]   defining in a computer the operation as a value chain, the value chain

containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure"

is an element that is subject to the processes of "Leadership...", "Communication...",

"Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales"

are characteristics associated with the "Infrastructure" element and related processes);

associating, using a computer, a process of the value chain with an element that

is subject to the process (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an

element that is subject to the processes of "Leadership...", "Communication...",

"Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales"

are characteristics associated with the "Infrastructure" element and related processes);

associating, using a computer, a characteristic with the associated process and

element (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is

subject to the processes of "Leadership...", "Communication...", "Resources", and

"Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are characteristics

associated with the "Infrastructure" element and related processes); and

displaying on a computer user interface the associated characteristic, process,

and element as associated (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an

element that is subject to the processes of "Leadership...", "Communication...",

"Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales"

are characteristics associated with the "Infrastructure" element and related processes);

[Claim 2]   wherein defining the operation comprises plotting the value chain on a

matrix (Fig. 4),

wherein associating the process and the element comprises mapping a plurality

of elements against the value chain on the matrix (Fig. 4), and

wherein associating the characteristic with the associated process and element

comprises indicating the characteristic of the associated process and element at an

intersection on the matrix corresponding to the associated process and element (Fig. 4);

and

wherein displaying comprises displaying the matrix on the computer user

interface (Fig. 4; ¶¶ 47-50);

[Claim 3]   wherein the plurality of elements are grouped by class, business unit, and

geography of the organization (Fig. 4 indicates that the elements, such as

"Infrastructure", fall under a given class, e.g., "Compliance Assessment Areas"; Figs. 6

and 7 specify a business/company location, i.e., geography, corresponding to the

elements);

[Claim 4]   wherein the class defines commonalities among a group of elements (Fig.

4 indicates that the elements, such as "Infrastructure", are common to a given class,

e.g., "Compliance Assessment Areas");

[Claim 5]   wherein the operation comprises an information technology operation, and

wherein the element comprises one of a client, a server, an enabler, and an application

(Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart and

resulting compliance risk assessment is used to generate the quality function

deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or

comprise, related IT applications, including "Information Systems" (Fig. 12) and "30.13

Product Development" and "Y2K Physical Product Upgrades" (Fig. 13));

[Claim 6]   wherein the characteristic of the associated process and element

comprises an actor responsible for furnishing the associated process and element (Fig.

4; ¶¶ 60-62 -- For example, "Infrastructure" is an element that is subject to the

processes of "Leadership...", "Communication...", "Resources", and "Discipline &

Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors responsible for

furnishing the associated process and element);

[Claim 7]   wherein the actor comprises one of the organization, an outsourcer for the

organization, and a third party to the organization and the outsourcer (Fig. 4; ¶¶ 60-62 --

- Actors within the organization become owners of certain elements and processes);

[Claim 10]   wherein the plurality of processes pertains to service measures, and

wherein the characteristic of the associated process and element comprises a service

level by which to measure the associated process and element (Fig. 4; ¶¶ 70, 85-91 --

The various elements are assessed in relation to compliance risks based on such areas as supplier agreements (¶ 70), i.e., expected service levels);

[Claim 11]   wherein the characteristic of the associated process and element comprises a cost for furnishing the associated process and element (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as carrying cost, financial controls, and expense approvals (¶¶ 69-70), i.e., cost for furnishing the associated process and element);

[Claim 12]   wherein the process is defined according to an industry standard (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as regulatory requirements (¶ 70), i.e., industry standards).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 8, 9, and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. (US 2002/0059093), as applied to claims 1, 6, and 8 above.

[Claim 8]   Barton discloses that the actor is an outsourcer and that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶ 70). However,

Barton does not expressly disclose that the outsourcer is contracted to furnish the

associated process and element, yet Official Notice is taken that it is old and well-known

in the art of outsourcing to outsource any processes typically associated with a

business, especially where such outsourcing would lower costs for the business. For

example, many businesses find it more cost effective to outsource their regulatory

monitoring and IT functions (both of which are related to processes and elements, as

shown in Figures 4, 12, and 13). Since Barton is directed toward assessing business

risks, including those associated with outsourcing and supplier agreements, the

Examiner asserts that it would have been obvious to one of ordinary skill in the art at the

time of Applicant's invention to modify Barton to expressly develop a contract between

the organization and the outsourcer for the outsourcer's furnishing of the associated

process and element in order to facilitate the outsourcing of business processes and

elements that are determined to be more efficiently and inexpensively performed by an

outside entity while maintaining sufficient compliance monitoring standards in effect.

[Claim 9]   Barton does not specify whether or not the evaluated business happens to

be a company participating in a merger; however, Barton does perform business risk

evaluations (¶¶ 69-70). Furthermore, Official Notice is taken that it is old and well-

known in the art of merger planning for companies involved in the merger to consider

various risk factors of each business when ultimately deciding to complete the merger

or not. This assessment provides each business with a more realistic understanding of

the pros and cons involved with the merger. Since Barton lays out groundwork for

evaluating business risks, the Examiner asserts that it would have been obvious to one

of ordinary skill in the art at the time of Applicant's invention to market Barton's invention

to companies participating in a merger in order to expand Barton's customer base,

thereby increasing Barton's likelihood to generate profit. It should also be noted that the

fact that the "actor comprises one of a first company participating in a merger and a

second company participating in the merger" does not affect the structure or

functionality recited in the claimed invention; therefore, the patentable weight merited by

such a limitation is questionable.

[Claim 13]   In order to evaluate the various compliance assessment areas and related

business risks and assign processes and elements to owners, or actors (as disclosed in

Figs. 4, 12, 13; ¶¶ 60-70), users of Barton's invention must at some level perform the

steps of relating, developing, contacting, fulfilling, operating, advising, and managing.

While Barton does not expressly define these steps as processes that are mapped out

against related elements, the Examiner asserts that it would have been obvious to one

of ordinary skill in the art at the time of Applicant's invention to utilize these specific

process labels (i.e., relate, develop, contact, fulfill, operate, advise, and manage) since

Barton's users effectively perform these processes, thereby allowing Barton's invention

to more comprehensively address processes specific to various types of organizations.

        Barton discloses a method for outsourcing comprising:

[Claim 14]   defining.in a computer a value chain containing a plurality of processes

(Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the

processes of "Leadership...", "Communication...", "Resources", and "Discipline &

Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are characteristics associated

with the "Infrastructure" element and related processes);

defining in a computer a collection of elements, wherein the collection of

elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example,

"Infrastructure" is an element that is subject to the processes of "Leadership...",

"Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR",

"Legal", and "Sales" are characteristics associated with the "Infrastructure" element and

related processes);

associating in a computer a process of the plurality of processes with an element

of the collection of elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an

element that is subject to the processes of "Leadership...", "Communication...",

"Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales"

are characteristics associated with the "Infrastructure" element and related processes);

associating in a computer an actor with the associated process and element,

wherein the actor furnishes the associated process and element (Figs. 4, 6, 7, 11, 12,

13, 17; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the

processes of "Leadership...", "Communication...", "Resources", and "Discipline &

Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the

"Infrastructure" element and related processes);

[Claim 15]   wherein associating the process of the plurality of processes with the

element of the collection of elements comprises mapping the plurality of processes

against the collection of elements in a matrix, and wherein associating the actor with the

associated process and element comprises listing the actor at an intersection of the

associated process and element within the matrix, and wherein displaying the scope

comprises displaying the populated matrix (Fig. 4);

[Claim 17]   wherein the process comprises a service measure, and the method further

comprises associating a service level with the associated process and element and

displaying the associated process, element, and service level on the computer user

interface (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to

compliance risks based on such areas as supplier agreements (¶ 70), i.e., expected

service levels);

[Claim 19]   wherein the plurality of processes comprises one of information

technology functions, human resource functions, finance and accounting functions,

procurement functions, call center functions, back-office functions, and mid-office

functions (Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart

and resulting compliance risk assessment is used to generate the quality function

deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or

comprise, related IT applications, including "Information Systems" (Fig. 12) and "30.13

Product Development" and "Y2K Physical Product Upgrades" (Fig. 13). ¶¶ 69-70

discusses various finance and accounting and procurement functions).

As per claims 14 and 16, Barton discloses that the actor is an outsourcer and

that a contract is developed between the organization and the outsourcer, as implied by

the fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶

70). However, Barton does not expressly disclose that a scope for the outsourcing

based on the associated actor, process, and element is defined and displayed, yet

Official Notice is taken that it is old and well-known in the art of outsourcing to outsource

any processes typically associated with a business, especially where such outsourcing

would lower costs for the business. For example, many businesses find it more cost

effective to outsource their regulatory monitoring and IT functions (both of which are

related to processes and elements, as shown in Figures 4, 12, and 13). Since Barton is

directed toward assessing business risks, including those associated with outsourcing

and supplier agreements, the Examiner asserts that it would have been obvious to one

of ordinary skill in the art at the time of Applicant's invention to modify Barton to

expressly define and display a scope for the outsourcing based on the associated actor,

process, and element (claim 14) wherein the outsourcing is between an organization

and an outsourcer for the organization, and wherein the actor is one of the organization,

the outsourcer, and a third party to the organization and the outsourcer (claim 16) in

order to facilitate the outsourcing of business processes and elements that are

determined to be more efficiently and inexpensively performed by an outside entity

while maintaining sufficient compliance monitoring standards in effect.

[Claim 18]   Barton discloses the step of associating a cost with associated process

and element and displaying the associated process and element on the computer user

interface (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to.

compliance risks based on such areas as carrying cost, financial controls, and expense

approvals (¶¶ 69-70), i.e., cost for furnishing the associated process and element);

however, Barton does not expressly teach that the cost is displayed on the computer

user interface. The Examiner submits that it is old and well-known in the art that

displaying multiple factors of an analysis on a user interface facilitates quick and

efficient understanding of the relationships among the various factors, thereby allowing

a user to more comprehensively glean the implications of such relationships. Since

Barton teaches the display of various processes and elements and Barton discloses

that cost contributes to the business risk evaluation, the Examiner asserts that it would

have been obvious to one of ordinary skill in the art at the time of Applicant's invention

to modify Barton to display an associated cost along with the process and element in

order to facilitate a quick and efficient understanding of the relationships among the

various factors, thereby allowing a user to more comprehensively glean the implications

of such relationships.

       Barton discloses a method for outsourcing comprising:

[Claim 20]   defining in a computer a value chain containing a plurality of processes

(Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the

processes of "Leadership...", "Communication...", "Resources", and "Discipline &

Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are characteristics associated

with the "Infrastructure" element and related processes);

       defining in the computer a collection of elements, wherein the collection of

elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example,

"Infrastructure" is an element that is subject to the processes of "Leadership...",

"Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR",

"Legal", and "Sales" are characteristics associated with the "Infrastructure" element and

related processes);

assigning in the computer the plurality of processes with the collection of

elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is

subject to the processes of "Leadership...", "Communication...", "Resources", and

"Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are characteristics

associated with the "Infrastructure" element and related processes);

displaying on a computer user interface the associations between the plurality of

processes and the collection of elements (Fig. 4; ¶¶ 39, 46-50 -- For example,

"Infrastructure" is an element that is subject to the processes of "Leadership...",

"Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR",

"Legal", and "Sales" are characteristics, or actors, associated with the "Infrastructure"

element and related processes);

assigning in the computer actors for the associated processes and elements,

wherein the actors are either an organization, an outsourcer for the organization, or a

third party to the organization and the outsourcer (Fig. 4; ¶¶ 60-62 --- Actors within the

organization become owners of certain elements and processes);

displaying on the computer user interface the actors for the associated processes

and elements (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is

subject to the processes of "Leadership...", "Communication...", "Resources", and

"Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are characteristics,

or actors, associated with the "Infrastructure" element and related processes);

[Claim 22]   wherein associating the plurality of processes with the collection of

elements comprises mapping the plurality of processes against the collection of

elements in a matrix (Figs. 4, 12, 13),

wherein assigning the actors comprises listing the actors at intersection of

processes and elements in the matrix (Fig. 4),

wherein displaying the plurality of processes and the collection of elements

comprises displaying the matrix (Figs. 4, 12, 13), and

wherein the interaction models comprise process maps indicating a swim-lane

boundary across which the interactions occur (Figs. 4, 12, 13).

As per claims 20-22, Barton discloses that the actor is an outsourcer and that a

contract is developed between the organization and the outsourcer, as implied by the

fact that the business analyzes its outsourcing (¶ 69) and supplier agreements (¶ 70).

However, Barton does not expressly disclose that a scope for the outsourcing based on

the associated actor, process, and element is defined and displayed, yet Official Notice

is taken that it is old and well-known in the art of outsourcing to outsource any

processes typically associated with a business, especially where such outsourcing

would lower costs for the business. For example, many businesses find it more cost

effective to outsource their regulatory monitoring and IT functions (both of which are

related to processes and elements, as shown in Figures 4, 12, and 13). Since Barton is

directed toward assessing business risks, including those associated with outsourcing

and supplier agreements, the Examiner asserts that it would have been obvious to one

of ordinary skill in the art at the time of Applicant's invention to modify Barton to

expressly identify, along with the value chain, interactions between the organization and

the outsourcer, create interaction models for the identified interactions, and display on a

computer user interface the interaction models (claim 20), wherein the interaction

models define a sequence by which to complete the plurality of processes and

information that is to be passed between the organization and the outsourcer (claim 21)

in order to facilitate the outsourcing of business processes and elements that are

determined to be more efficiently and inexpensively performed by an outside entity

while maintaining sufficient compliance monitoring standards in effect.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Covington, III et al. (US 2003/0083912) -- Discloses a system/method for

optimizing business processes and tools, incorporating an assessment of outsourcing.

Maeda (US 2003/0158768) -- Discloses the use of a matrix process to assess an

outsourcing model.

Vellante et al. (US 2002/0069102) -- Discloses a method and system for

assessing and quantifying the business value of an information technology (IT)

application or set of applications.

Keefe et al. (US 2004/0044551) -- Discloses an evaluation of cost savings associated with outsourcing.

Vashistha et al. (US 2001/0051913) -- Discloses a method and system for outsourcing technology projects and services.

14.   This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Susanna Diaz

Susanna M. Diaz
Primary Examiner
Art Unit 3623

June 2, 2005

37 CFR § 1.105 - Requirement for Information

1.   Applicant and the assignee of this application are required under 37 CFR 1.105

to provide the following information that the examiner has determined is reasonably

necessary to the examination of this application.

The assignee of the instant application is Shaw Pittman, LLP. The Applicants of

record are Douglas S. Parker and Joseph E. Nash. The Examiner has located what

appears to be a description of Applicants' invention (i.e., with reference made to "Global

Sourcing," as seen on page 1) on the Internet at [URL:

http://www.sourcinginterests.org], dated August 28, 2003 and listed as patent pending

(page 42). While this document does not serve as prior art, it lists Trevor W. Nagel and

Douglas S. Parker as authors. The Examiner requests clarification regarding the

inventorship of the instant application in light of this discrepancy between the inventors

and authors. Additionally, the reference "Siemens Business Services Receive Five-

Year Contract Extension Providing SieQuence State 2 Solutions to MetLife" states that

Shaw Pittman Global Sourcing is a major player in the outsourcing and consulting

industry (page 2). Please provide details regarding any prior art products or services

developed or known of by Applicants or assignee. For example, when did

Applicants/assignee first offer or disclose the service described in the aforementioned

web site to the public?

Furthermore, the following references discuss Shaw Pittman's role in the

business process outsourcing industry:

"Noted Outsourcing Expert Joins Craig Claims Management, Ltd."

"Shaw Pittman Announces Merger with Klein & Martin LLP"

"Notable Technology Outsourcing Specialist Joins O'Melveny & Myers LLP"

"TBI Announces Opening of European Outsourcing and Metrics Practice at Second Annual IT Service Executive Dinner"

"Business Strategy Network Announces Upcoming Conference"

"Technology Partners International (TPI) Partner Program Sets Sail With Successful Launch"

"Don't Just Sign on the Dotted Line"

"IT Advantage -- Source of Success -- Outsourcing Is No Longer Limited to Back-Office Functions"

Again, assignee is clearly a major player in the outsourcing and consulting industry. Please provide details regarding any prior art products or services developed or known of by Applicants or assignee.

2.   The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement
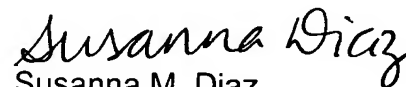
under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37

C.F.R. § 1.97.

3.   The applicant is reminded that the reply to this requirement must be made with

candor and good faith under 37 CFR 1.56. Where the applicant does not have or

cannot readily obtain an item of required information, a statement that the item is

unknown or cannot be readily obtained will be accepted as a complete response to the

requirement for that item.

4.   This requirement is an attachment of the enclosed Office action. A complete

response to the enclosed Office action must include a complete response to this

requirement. The time period for reply to this requirement coincides with the time period

for reply to the enclosed Office action, which is three (3) months.

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-

6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Susanna M. Diaz
Primary Examiner
Art Unit 3623

June 1, 2005

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600